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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,349	09/11/2003	Benjamin Oshlack	200.1138CON	7890

7590 10/04/2007  
Davidson, Davidson & Kappel, LLC  
14th Floor  
485 Seventh Avenue  
New York, NY 10018

EXAMINER
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SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/660,349

Applicant(s)

OSHLACK ET AL.

Examiner

Humera N. Sheikh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/11/03; 1/14/05</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of the Application**

Receipt of the Response filed 06/27/05 and the Information Disclosure Statements (IDS) filed 09/11/03 and 01/14/05 is acknowledged.

Upon further review and consideration, the previous *Ex Parte Quayle* Office Action filed 05/31/05 has been withdrawn. The following are the new grounds for rejection:

Claims 1-38 are pending in this action. Claims 18, 27 and 37 have been amended. Claims 1-38 are rejected.

### ***Inventorship***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

\* \* \* \* \*

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palermo (WO 99/32120).**

**Palermo (WO '120)** teaches an oral dosage form of an opioid analgesic, comprising an analgesically effective amount of an opioid agonist together with an opioid antagonist, the amount of opioid antagonist including being sufficient to counteract opioid effects if extracted together with the opioid agonist (see p. 6, lines 1-18).

In certain preferred embodiments, the opioid agonist is hydrocodone, hydromorphone, oxycodone, morphine or pharmaceutically acceptable salts thereof (p. 7, lines 5-6). Suitable opioid antagonists disclosed include naltrexone, naloxone, nalmephene, cyclazocine and

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levallorphan. A most preferred antagonist is naltrexone (p. 11, lines 14-19); (p. 13, lines 14-31). In certain preferred embodiments of the method, the opioid agonist and the opioid antagonist are combined in a ratio of opioid antagonist to opioid agonist which is analgesically effective when the combination is administered orally, but which is aversive in a physically dependent subject (p. 7, lines 7-15). In embodiments where the opioid is hydrocodone and the antagonist is naltrexone, the ratio of naltrexone to hydrocodone is preferably from about 0.03-0.27:1 by weight (p. 7, lines 15-26).

Palermo teaches that the dosage forms of the invention may be liquids, tablets, multiparticulates, dispersible powders or granules, hard or soft capsules, lozenges, aqueous or oily suspensions, emulsions, syrups, elixirs, microparticles, buccal tablets, etc. (p. 7, lines 27-31); (p. 8, line 29 – p. 9, line 1). In certain preferred embodiments, the oral dosage forms are sustained release formulations. This may be accomplished via the incorporation of a sustained release carrier into a matrix containing the opioid agonist and opioid antagonist; or via a sustained release coating of a matrix containing the opioid agonist and opioid antagonist, where the sustained release coating contains at least a portion of the sustained release carrier included in the dosage form (p. 8, lines 1-9); (p. 20, lines 16-21).

With regards to ratios, Palermo teaches that the combinations of opioid antagonists/opioid agonists which are orally administered in ratios which are equivalent to the ratio of e.g., naltrexone to hydrocodone set forth are considered to be within the scope of the invention. For example, in some embodiments, naloxone is utilized as the opioid antagonist, the amount of naloxone included in the dosage form being large enough to provide an

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equiantagonistic effect as if naltrexone were included in the combination (p. 19-31). This demonstrates bioequivalency of the dosage forms.

Palermo teaches that the dosage forms may be coated with one or more materials suitable for the regulation of release or the protection of the formulation. The coatings are provided to permit either pH-dependent or pH-independent release (p.21, lines 18-29).

In preferred embodiments, the substrate (e.g., tablet core bead, matrix particle) containing the opioid analgesic is coated with a hydrophobic material selected from (i) an alkylcellulose; (ii) an acrylic polymer or (iii) mixtures thereof (p. 22, lines 6-14).

Suitable and preferred alkylcellulose polymers taught include ethylcellulose (p. 22, lines 19-25). Acrylic polymers are also disclosed and include acrylic acid and methacrylic acid copolymers, methyl methacrylate copolymers, ethoxyethyl methacrylates, cyanoethyl methacrylate, poly(acrylic acid), poly(methacrylic acid) and the like (p. 23, line 10 – p. 24, line 22); (p. 29, lines 7-18). Plasticizers can also be included in the composition (p. 24, line 24 – p. 25, line 20). A process for preparing coated beads is disclosed at p. 25, line 21 – p. 28, line 8. Matrix bead formulations are disclosed at page 28. Hydrophilic and/or hydrophobic materials, such as gums, cellulose ethers, acrylic resins, protein derived materials and any pharmaceutically acceptable hydrophobic material or hydrophilic material, which is capable of imparting, controlled release of the active agent and which melts (or softens to the extent necessary to be extruded) may be used in this invention (p. 28, lines 19-30).

With regards to amounts of hydrophobic material claimed, the Examiner notes that suitable or effective amounts can be determined by one of ordinary skill in the art through routine or manipulative experimentation to obtain optimal results, as these are variable

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parameters attainable within the art. Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

The Palermo reference explicitly recognizes and teaches oral dosage forms comprising opioid agonists in combination with opioid antagonists, whereby the dosage forms are effective for the substantial reduction of pain. Given the teachings of Palermo, the instant invention, when taken as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

\* \* \* \* \*

**Claims 27-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palermo (WO 99/32120), as applied to claims 1-26 above and further in view of Elger *et al.* (U.S. Pat. No. 4,844,907).**

**Palermo (WO ‘120)** teaches an oral dosage form of an opioid analgesic, comprising an analgesically effective amount of an opioid agonist together with an opioid antagonist, the amount of opioid antagonist including being sufficient to counteract opioid effects if extracted together with the opioid agonist (see p. 6, lines 1-18). In certain preferred embodiments, the opioid agonist is hydrocodone, hydromorphone, oxycodone, morphine or pharmaceutically acceptable salts thereof (p. 7, lines 5-6).

Palermo does not explicitly teach *layered* dosage forms.

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Elger *et al.* ('907) teach a pharmaceutical composition for the treatment of pain comprising a narcotic analgesic and a non-steroidal anti-inflammatory drug, whereby the composition is in the form of a multi-phase, layered tablet, especially bi-layered tablet (see reference column 1, line 1 – col. 2, line 3) and Abstract.

Suitable narcotic analgesics disclosed include hydrocodone, morphine and codeine (see Table at column 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the layered dosage forms of Elger *et al.* within the formulations of Palermo. One of ordinary skill in the art would do so because Elger *et al.* teach layered pharmaceutical compositions comprising narcotic analgesics and teach that the layered dosage forms (*i.e.*, bi-layered dosage forms) provide for separation of different drugs or phases. The expected result would be an improved multi-layered dosage formulation for the effective treatment of pain.

Hence, the instant invention, when taken as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

--No claims are allowed at this time.



*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday during regular business hours. (Wednesdays - Telework).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
HUMERA N. SHEIKH  
PRIMARY EXAMINER

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October 01, 2007

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